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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/798,115	02/12/97	ALLEMAN	J PARA-1479

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EXAMINER

HUNTER, D

ART UNIT	PAPER NUMBER
2742	33

DATE MAILED: 02/17/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/798,115	Applicant(s) Alleman
	Examiner Daniel Hunter	Group Art Unit 2742



Responsive to communication(s) filed on Sep 15, 1998

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 21-31 is/are pending in the application.
 Of the above, claim(s) _____ is/are withdrawn from consideration.
 Claim(s) _____ is/are allowed.
 Claim(s) 21-31 is/are rejected.
 Claim(s) _____ is/are objected to.
 Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
 The drawing(s) filed on _____ is/are objected to by the Examiner.
 The proposed drawing correction, filed on _____ is approved disapproved.
 The specification is objected to by the Examiner.
 The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 All Some* None of the CERTIFIED copies of the priority documents have been
 received.
 received in Application No. (Series Code/Serial Number) _____.
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892
 Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
 Interview Summary, PTO-413
 Notice of Draftsperson's Patent Drawing Review, PTO-948
 Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 21-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-27 of copending Application No. 08/252,984. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in this application are generic to the specific claims in copending Application 08/252.984. See *In re Van Ornum*, *supra* at 761, 763; *see also In re Goodman*, 29 USPQ 2d 2010 (CAFC 1993).

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

4. Claims 21-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 25, line 7, "the direct inward dial line" lacks antecedent basis. In lines 8/9, the following phrase lacks antecedent basis: "the number entered by the subscriber on the first circuit". In line 10, the following phrase lacks antecedent basis: "the called party on the second circuit".

Claims 22-25 are rejected as being dependent upon a rejected base claim.

5. Claims 26-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 26 line 8, the following phrase lacks antecedent basis: "the number of the called number".

Claims 27-30 are rejected as being dependent upon a rejected base claim.

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Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In line 5, the following term lacks antecedent basis: "the number of the called party".

6. Applicant argues in the Appellant's brief against the 35 USC 112 first and second paragraph rejections made in the final action. Based on the response filed by the Applicant, claims 24, 27, and 28, rejected under 35 USC first paragraph, are read such that the indication of an invalid call attempt provided to a subscriber when they dial another number other than his direct inward dial number is only that the subscriber will not get a call at the number at which they thought they would.

With regard to the rejection under 35 USC 112 second paragraph, the rejection made in the final action is restated and additional rejections are applied. Applicant's arguments were considered, and the rejections made herein differ from those made in the parent case.

Allowable Subject Matter

7. Claims 21-31 would be allowable upon the filing of an appropriate terminal disclaimer and the corrections to the 35 USC 112 second paragraph issues presented above.

8. The following is a statement of reasons for the indication of allowable subject matter: Claim 31, the broadest remaining claim, cites in Jepson format in improvement in call-back in which the subscriber calls a direct inward dial number, and hangs up before a charge is incurred.

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Retske¹ clearly indicates that this technique was known; however, insufficient evidence regarding the date of the use of DID in call back systems, nor evidence describing the extent to which the method was known by others, is available to determine whether the device described in Retske meets the requirements of 35 USC 102 (a), (b), or (g). *See In re Schlitter*, 234 F.2d 882, 110 USPQ 304 (CCPA 1956); *Dunlop Holdings LTD. v. Ram Golf Corp*, 524 F.2d 33, 188 USPQ 481 (Seventh Circuit 1975). Given the limited evidence available, the examiner is unable to establish a *prima facia* case against the pending claims.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Hunter whose telephone number is (703) 308-6732.



Daniel S. Hunter
Primary Examiner

¹Gene Retske, *The International CallBack Book; an Insider's View*, Flatiron Publishing, INC., Page 16, First Edition (February 1995).